



Express Mailing No. EV 001 404 647 US

PATENT APPLICATION
Docket No: 13768.67.14.1.1.1

SC
#17
12/1/2001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Nick Holt, et al.

Serial No.: 08/938,468) Art Unit

Confirmation No.: 2889) 2176

Filed: August 14, 1996)

For: METHOD AND SYSTEM FOR CUSTOMIZING
FORMS IN AN ELECTRONIC MAIL SYSTEM)

Examiner: Bashore, William)

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RESPONSE "B"

Assistant Commissioner for Patents
Washington, D. C. 20231

Sir:

Responsive to the Office Action of July 17, 2001, Applicants provide the following remarks regarding the references cited in the Office Action and respectfully request allowance of the patent application for the reasons discussed below.

The Office Action rejected claims 7, 9-11, 29 and 44-46. Under 35 U.S.C. § 103a as being unpatentable over U.S. Patent No. 5,119,472 to Texier in view of U.S. Patent No. 5,745,712 to Turpin. Claims 8, 12-15, 17, 19, 21-26 and 43 were rejected under 35 U.S.C. §

103a as being unpatentable over Texier in view of Turpin and further in view of U.S. Patent No. 5,404,294 to Karnik.

In response to these rejections, applicants respectfully submit that Turpin does not represent prior art for the subject matter for which it was cited in the Office Action, based on the effective filing dates of Turpin. Thus, as further described below, applicants respectfully submit that the examiner has failed to make a *prima facie* case of obviousness of the claimed invention. Because it is applicants' position that Turpin does not represent prior art, it has not been necessary for applicants to directly address the substance of the claim rejections or the question as to whether those portions of the cited references that do represent prior art in fact teach or suggest the elements of the claims. Thus, this response should not be seen as an acquiescence in the characterization of the disclosure of the cited references or the elements of the claims.

As noted at page 2 of the Office Action of July 17, 2001, the present application has an effective filing date of November 30, 1990 based on its claim of priority to a parent application filed on that date.

U.S. Patent No. 5,745,712 to Turpin was filed on December 28, 1995. Turpin '712 patent is a divisional of U.S. Patent No. 5,608,898, filed November 12, 1992, which is a continuation in part of U.S. Patent Application Serial No. 07/606,537, filed October 31, 1990, now abandoned. To summarize the remarks made below, applicants respectfully assert that much of the subject matter of Turpin '712 cited in the Office Action to reject the claims was not disclosed in the '537 application and therefore does not have an effective filing date early enough that would qualify it as prior art under 35 U.S.C. § 102.

Turpin '712 has apparently been cited in the Office Action as being § 102e prior art that is applied under § 103a in combination with other references to make an obviousness rejection of

the claims. In order to assist the examiner in identifying the subject matter of Turpin '712 that was included in the parent application '537 of October 31, 1990, applicants have attached as Exhibit A a copy of the '537 application that applicants have obtained from the United States Patent and Trademark Office. Any subject matter that was included in Turpin '712 but was not included in the '537 application cannot be prior art with respect to the present application, since any such subject matter was introduced into the '712 application no earlier than November 12, 1992, which is the filing date of the continuation in part of '898 application.

Applicants will now proceed to highlight the differences between the '537 application and Turpin '712 on a passage by passage basis in view of that which was cited in the office action of July 17, 2001.

In regard to claim 7, the Office Action states that Texier teaches "The creation of a custom form," and then proceeds to list a series of items that come according to the Office Action, are not taught by Texier but are taught by Turpin '712.

First, the Office Action states that "Turpin teaches a form creation tool comprising a tool bar of various items for field customization in a form." For support, the Office Action references the abstract, Figures 35a-35e and column 21, lines 45-63. Applicants respectfully point out that Figures 35a-35e and the corresponding description of column 21, lines 45-63 are not included in the '537 application. Applicants point out that the '537 application includes only 34 figures.

The Office Action, in regard to claim 7, further states that "Turpin also teaches defined behaviors in the form of operation trees assigned to fields, said tree can be copied to a new field." Applicants point out that column 26, lines 6-21 of Turpin '712 is not included in the '537 application.

The Office Action also refers to “Zones” of Turpin ‘712, which the Office Action equates to the custom field of claim 7. For support, the Office Action refers to Figure 1, column 6, lines 46-56 and column 8, lines 1-12. Applicants respectfully point out that the glossary of Turpin ‘712, which includes the portions of columns 6 and column 8 referenced in the Office Action, was not included in the ‘537 application.

Thus, with respect to these elements of claim 7, the only portion of Turpin ‘712 cited in the Office Action that is also included in Application ‘537 is the Abstract. Applicants respectfully submit that the Abstract of Turpin fails to teach or suggest these elements of claim 7. Because column 6, lines 6-21 of Turpin ‘712 were not included in the ‘537 application, applicants respectfully submit that Turpin fails to teach or suggest these limitations.

The other independent claims, namely, 12, 19, and 29, include limitations substantially similar to those of claim 7 discussed above. The Office Action also referenced the same portions of Turpin ‘712 as were referenced by the Office Action to reject claim 7. Thus, applicants respectfully submit that Turpin ‘712 is not prior art for the subject matter for which it was cited in the Office Action. Accordingly, claim 7, 12, 19, and 29 distinguish from the cited references.

In view of the foregoing, applicants respectfully assert that the Office Action fails to make a *prima facie* case of obviousness for any of the rejected claims. In the event that a subsequent Office Action presents a *prima facie* case of obviousness, applicants reserve the right to amend the claims, address the substantive distinctions between the claims and Texier, Karnik, and those portions of Turpin ‘712 that were disclosed in Application ‘537, or, if necessary, establish an invention date prior to October 31, 1990, which is the filing date of the ‘537 application.

For the foregoing reasons, Applicants submit that the pending claims are in condition for allowance and courteously request favorable action. If there are any outstanding issues that could be resolved by telephone, the Examiner is invited to contact the undersigned attorney.

Dated this 13rd day of November, 2001.

Respectfully submitted,



R. BURNS ISRAELSEN
Attorney for Applicant
Registration No. 42,685



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PATENT TRADEMARK OFFICE

WORKMAN, NYDEGGER & SEELEY
1000 Eagle Gate Tower
60 East South Temple
Salt Lake City, Utah 84111
Telephone: (801) 533-9800
Facsimile: (801) 328-1707

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		Application	08/938,468
		Filing Date	August 14, 1996
		First Named	Nick Holt, et al.
		Group Art Unit	2176
		Examiner Name	Bashore, William
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ENCLOSURES (check all that apply)

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	R. Burns Israelsen Workman, Nydegger & Seeley
Signature	
Date	November 13 th , 2001

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